

AUS920010819US1
BRIEF IN SUPPORT OF REINSTATEMENT OF APPEAL

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	§	
Michael W. Brown, <i>et al.</i>	§	Group Art Unit: 2645
Serial No.: 10/015,281	§	Examiner: Elahee, MD S.
Filed: December 12, 2001	§	Atty Docket No.: AUS920010819US1
Title: Intermediary Device Initiated	§	Customer No.: 34533
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SUPPLEMENTAL APPEAL BRIEF IN SUPPORT
OF REINSTATEMENT OF APPEAL

Honorable Commissioner:

This is a Supplemental Appeal Brief submitted in response to a Notice of Non-Compliant Appeal Brief mailed on November 14, 2006. The Notice of Non-Compliant Appeal Brief was issued in response to the filing of a Supplemental Appeal Brief in support of reinstatement of the Appeal filed pursuant to 37 CFR § 41.37 in response to the Examiner's reopening of prosecution. This Supplemental Appeal Brief is responsive to the rejections issued in an Office Action dated August 25, 2005. This is a Supplemental Appeal brief supporting the third appeal filed in this case. In two previous instances, upon receiving an Appeal Brief, the Examiner has reopened prosecution. Applicants hereby again request that the Appeal in this case be reinstated.

BRIEF IN SUPPORT OF REINSTATEMENT OF APPEAL**REAL PARTY IN INTEREST**

The real party in interest is the patent assignee, International Business Machines Corporation ("IBM"), a New York corporation having a place of business at Armonk, New York 10504.

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

STATUS OF CLAIMS

Claims 1-21, 52, and 53 are pending in the case. All pending claims are on appeal.

STATUS OF AMENDMENTS

No amendments were submitted after final rejection. The claims as currently presented are included in the Appendix of Claims that accompanies this Appeal Brief.

SUMMARY OF CLAIMED SUBJECT MATTER

Appellants provide the following summary of the claimed subject matter according to 37 CFR § 41.37(c)(1)(v). This summary includes a concise explanation of the subject matter defined in each of the independent claims involved in the appeal and includes references to Appellants' original specification by page and line number and to the drawings by reference characters. The five independent claims involved in this appeal are claims 1, 10, 18, 52 and 53. Claim 1 recites a method of externally identifying a particular caller. Claims 10 and 18 recite counterpart aspects of the method of claim 1. Claim 10 recites systems aspects of the method of claim 1. Claim 18 recites computer program product aspects of the method of claim 1. Claim 52 recites a controlling caller identification. Claim 53 recites a method for controlling a call.

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Claim 1 recites a method for externally identifying a particular caller (described for example at page 37, line 18 – page 39, line 26 with reference to Figure 5). The method of claim 1 includes receiving a voice utterance for a caller at a server external to a trusted telephone network (described for example at page 38, lines 15-25 with reference to S24 of Figure 5). The method of claim 1 also includes identifying a caller identity associated with said voice utterance at said server (described for example at page 38, line 26-page 39, line 10 with reference to S25 of Figure 5), such that said caller identity is transmittable within said trusted telephone network as an authenticated identity of said caller for a call (described for example at page 38, line 26-page 39, line 10 with reference to S25 of Figure 5).

Claim 10 recites a system for externally identifying a particular caller (described for example at page 37, line 18 – page 39, line 26 with reference to Figure 5 and page 30 lines 22- page 32, line 23 with reference to Figure 3). The system of claim 10 includes a server system communicatively connected to a trusted telephone network by an external network (described for example at page 31, lines 10-17 with reference to reference numerals 22 and 20 of Figure 3). The system of claim 10 also includes means for receiving a voice utterance for a caller at said server system (described for example at page 38, lines 15-25 with reference to S24 of Figure 5 and page 30 line 26-page 31, line 20 with reference to reference numerals 42, 20, 46, and 22 of Figure 3). The system of claim 10 also includes means for identifying a caller identity associated with said voice utterance (described for example at page 38, line 26-page 39, line 10 with reference to S25 of Figure 5 and page 31, lines 20-27 with reference to reference numerals 22 and 42 of Figure 3). The system of claim 10 also includes means for transmitting said caller identity to said trusted telephone network as an authenticated identity of said caller for a call (described for example at page 38, line 26-page 39, line 10 with reference to S25 of Figure 5 and page 31, lines 20-27 with reference to reference numerals 22 and 42 of Figure 3).

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Claim 18 recites a computer program product for externally identifying a particular caller (described for example at page 37, line 18 – page 39, line 26 with reference to Figure 5 and page 39, line 27- page 40, line 16 and page 30 lines 22- page 32, line 23 with reference to Figure 3). The computer program product of claim 18 includes a recording medium (described for example at page 39, line 27- page 40, line 16). The computer program product of claim 18 also includes means, recorded on said recording medium, for enabling receipt of a voice utterance for a caller at a server system communicatively connected to a trusted telephone network via an external network (described for example at page 38, lines 15-25 with reference to S24 of Figure 5 and page 30 line 26-page 31, line 20 with reference to reference numerals 42, 20, 46, and 22 of Figure 3). The computer program product of claim 18 includes means, recorded on said recording medium, for identifying a caller identity associated with said voice utterance (described for example at page 38, line 26-page 39, line 10 with reference to S25 of Figure 5 and page 31, lines 20-27 with reference to reference numerals 22 and 42 of Figure 3). The computer program product of claim 18 includes means, recorded on said recording medium, for controlling transmission of said caller identity to said trusted telephone network as an authenticated identity of said caller for a call (described for example at page 38, line 26-page 39, line 10 with reference to S25 of Figure 5 and page 31, lines 20-27 with reference to reference numerals 22 and 42 of Figure 3).

Claim 52 recites a method for controlling caller identification (described for example at page 37, line 18 – page 39, line 26 with reference to Figure 5 and page 23, lines 20-27 with reference Figure 1). The method of claim 52 includes receiving, from a trusted telephone network, an authenticated caller identity for a caller at a telephony device (described for example page 37, line 18 – page 39, line 26 with reference to Figure 5), wherein said caller identity is authenticated at a authentication service accessible via a network external to said trusted telephone network, wherein said trusted telephone network initiates said authentication service (described for example at page 38, lines 15-25 with reference to S24 of Figure 5 and page 38, line 26-page 39, line 10 with reference to S25 of Figure 5). The method of claim 52 includes controlling output of said authenticated caller identity from said telephony device, such that an individual with

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access to said telephony device is informed of the identity of said caller (described for example at page 23, lines 20-27 with reference to reference numerals 8a-8n of Figure 1).

Claim 53 recites a method for controlling a call (described for example at page 37, line 18 – page 39, line 26 with reference to Figure 5). The method of claim 53 includes receiving, at a telephony device, a secure communication channel via a trusted telephone network to an authentication service, wherein said trusted telephone network initiates said authentication service (described for example page 38, lines 5-15). The method of claim 53 also includes facilitating, from said telephony device, communications between said authentication service and a caller, such that said authentication service is enabled to authenticate an identity of said caller (described for example at page 38, lines 15-25 with reference to S23 and S24 of Figure 5).

GROUNDS OF REJECTION

Claim 52 stands rejected under 35 U.S.C § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Claims 1, 3-5, 7, 10, 12-14, 16, 20, 21, and 52 stand rejected under 35 U.S.C § 102(b) as being anticipated by McAllister, *et al.* (U.S. Patent No. 6,038,305). Claims 2, 9, 11, 19, and 53 stand rejected under 35 U.S.C § 103(a) as unpatentable over McAllister, *et al.* (U.S. Patent No. 6,038,305) in view of Zirngibl, *et al.* (U.S. Pub. No. 2005/014679). Claims 6 and 15 stand rejected under 35 U.S.C § 103(a) as unpatentable over McAllister, *et al.* (U.S. Patent No. 6,038,305) in view of McAllister, *et al.* (U.S. Patent No. 6,442,242). Claims 8 and 17 stand rejected under 35 U.S.C § 103(a) as unpatentable over McAllister, *et al.* (U.S. Patent No. 6,038,305) in view of Yoon, *et al.* (U.S. Pub. No. 2001/0047414).

BRIEF IN SUPPORT OF REINSTATEMENT OF APPEAL**ARGUMENT****HISTORY OF PROSECUTION**

This case has been in prosecution since December 12, 2001. In over four years of prosecution, the five office actions have relied on at least five different citations of references for rejections under 35 U.S.C § 102. The current Office Action of August 25, 2005, relies on McAllister for the rejections under 35 U.S.C § 102(b). The Office Action of August 25, 2005, does not however refer or address the previous rejections contained in the Final Office Action dated August 12, 2004, and traversed in the Appeal Brief of December 7, 2004, and does not refer or address the previous rejections contained in the Office Action dated March 24, 2005, issued upon reopening prosecution and traversed in the Supplemental Appeal Brief filed on May 23, 2005. To the extent that those previous grounds of rejection are still pending, Applicants hereby incorporate by reference the entirety of the Appeal Brief filed on December 7, 2004, the Supplemental Appeal Brief filed on May 23, 2005, and maintain the traversal of all previous ground of rejection.

REJECTION UNDER 35 U.S.C § 112, SECOND PARAGRAPH

Claim 52 stands rejected under 35 U.S.C § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Office Action of August 25, 2005, rejects claim 52 stating that the words "said telephony device" in the phrase "an individual with access to said telephony device of the claim" are directed to two telephony devices. Office Action of August 25, 2005, page 2. The phrase "telephony device" in claim 52 is not indefinite and refers to only one telephony device—the device at which the authenticated caller identity for the caller is received, which is also the device from which output is controlled. The phrase "said telephony device" has antecedent basis, "a telephony device" in line 3 of the claim. Each subsequent use of the phrase "telephony device" is preceded by the word "said" indicating that the telephony device is the same telephony device introduced in the claim at line 3.

REJECTION UNDER 35 U.S.C § 102(b) OVER MCALLISTER

Claims 1, 3-5, 7, 10, 12-14, 16, 20, 21, and 52 stand rejected under 35 U.S.C § 102(b) as being anticipated by McAllister (U.S. Patent No. 6,038,305). To anticipate claims 1, 3-5, 7, 10, 12-14, 16, 20, 21, and 52 under 35 U.S.C. § 102(b), two basic requirements must be met. The first requirement of anticipation is that McAllister must disclose each and every element as set forth in Applicants' claims. The second requirement of anticipation is that McAllister must enable Applicants' claims. McAllister does not meet either requirement and therefore does not anticipate Applicants' claims.

**McAllister Does Not Disclose Each and Every Element of
Applicants' Claims 1, 3-5, 7, 10, 12-14, 16, 20, 21, and 52**

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). McAllister does not disclose each and every element of claim 1. Independent claim 1 claims:

A method for externally identifying a particular caller, said method comprising:

receiving a voice utterance for a caller at a server external to a trusted telephone network; and

identifying a caller identity associated with said voice utterance at said server, such that said caller identity is transmittable within said trusted telephone network as an authenticated identity of said caller for a call.

The Office Action of August 25, 2005, states that Figure 4A and Figure 4B, column 13, lines 2-41, column 19, lines 49-67, column 20, lines 1-12 and 22-29 of McAllister

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disclose "receiving a voice utterance for a caller at a server external to a trusted telephone network" as claimed in claim 1 of the present application. The Office Action defines a trusted telephone network of McAllister as only the central office 11 and an SS7 network citing column 11, line 62 and Figure 1. The actual text of McAllister disputes such a definition. Column 11, line 62 is general description of protocols useful in communicating with an Intelligent Peripheral ('IP') and is not in any way a definition of trusted or untrusted networks and in no way defines a trusted telephone network as only a central office and SS7 network. As such, McAllister fails to disclose each and every element of claim 1. The rejection should be withdrawn and the case should be allowed.

Regarding Figure 1, McAllister explicitly describes Figure 1 as illustrating a single network stating "FIG. 1 provides a simplified illustration of *the* preferred intelligent telephone network for implementing the personal dial tone service in accord with the present invention." McAllister, column 8 lines 37-41, emphasis added. In fact, McAllister does not even mention "trusted telephone networks." McAllister does not disclose "receiving a voice utterance ... at a server external to a trusted telephone network" as claimed in claim 1 of the present application. As such, McAllister fails to disclose each and every element of claim 1. The rejection should be withdrawn and the case should be allowed.

Claims 3-5, and 7 depend from independent claim 1 and include all of the limitations of claim 1. Because McAllister does not disclose each and every element of claim 1, McAllister does not disclose each and every element of claims 3-5, and 7. As such, claims 3-5, and 7 are also patentable and should be allowed.

Independent claim 10 claims "[a] system for externally identifying a particular caller" including "means for transmitting said caller identity to said trusted telephone network as an authenticated identity of said caller for a call." As mentioned above, McAllister does not disclose trusted telephone networks and therefore, McAllister does not disclose "[a] system for externally identifying a particular caller" including "means for transmitting said caller identity to said trusted telephone network as an authenticated identity of said

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caller for a call." As such, independent claim 10 is not anticipated by McAllister and therefore should be allowed.

Rejected dependent claims 12-14, and 16 depend from claim 10 and include all of the limitations of claim 10. Because McAllister does not disclose each and every element of claim 10, McAllister also does not disclose each and every element of claims 12-14, and 16. Claims 12-14, and 16 should be allowed.

Independent claim 18 recites "[a] computer program product for externally identifying a particular caller" including "means, recorded on said recording medium, for controlling transmission of said caller identity to said trusted telephone network as an authenticated identity of said caller for a call." As discussed above, McAllister discloses trusted telephone networks and therefore does not disclose "[a] system for externally identifying a particular caller" including "means for transmitting said caller identity to said trusted telephone network as an authenticated identity of said caller for a call." As such, independent claim 18 is not anticipated by McAllister and therefore should be allowed.

Rejected dependent claims 20 and 21 depend from claim 18 and include all of the limitations of claim 18. Because McAllister does not disclose each and every element of claim 18, McAllister also does not disclose each and every element of claims 20 and 21. Claims 20 and 21 should be allowed.

Independent claim 52 claims:

A method for controlling caller identification, comprising:

receiving, from a trusted telephone network, an authenticated caller identity for a caller at a telephony device, wherein said caller identity is authenticated at a authentication service accessible via a network external to said trusted telephone network, wherein said trusted telephone network initiates said authentication service; and

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controlling output of said authenticated caller identity from said telephony device, such that an individual with access to said telephony device is informed of the identity of said caller.

As discussed above, McAllister does not disclose trusted telephone networks and therefore McAllister does not disclose each and every element of claim 52. As such, independent claim 52 is not anticipated by McAllister and therefore should be allowed.

McAllister Does Not Enable
Applicants' Claims 1, 3-5, 7, 10, 12-14, 16, 20, 21, and 52

Not only must McAllister discloses each and every element of claims 1, 3-5, 7, 10, 12-14, 16, 20, 21, and 52 of the present invention within the meaning of *Verdegaal* in order to anticipate Applicants' claims, but also McAllister must be an enabling disclosure of Applicants' claims 1, 3-5, 7, 10, 12-14, 16, 20, 21, and 52 within the meaning of *In re Hoeksema*. In *Hoeksema*, the claims were rejected because an earlier patent disclosed a structural similarity to the applicant's chemical compound. The court in *Hoeksema* stated: "We think it is sound law, consistent with the public policy underlying our patent law, that before any publication can amount to a statutory bar to the grant of a patent, its disclosure must be such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention." *In re Hoeksema*, 399 F.2d 269, 273, 158 USPQ 596, 600 (CCPA 1968). The meaning of *Hoeksema* for the present case is that unless McAllister places Applicants' claims 1, 3-5, 7, 10, 12-14, 16, 20, 21, and 52 in the possession of a person of ordinary skill in the art, McAllister is legally insufficient to anticipate Applicants' claims 1, 3-5, 7, 10, 12-14, 16, 20, 21, and 52 under 35 USC 102(e). Claims 1, 3-5, 7, 10, 12-14, 16, 20, 21, and 52 are therefore patentable and should be allowed.

McAllister does not enable claim 1. Independent claim 1 claims:

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A method for externally identifying a particular caller, said method comprising:

receiving a voice utterance for a caller at a server external to a trusted telephone network; and

identifying a caller identity associated with said voice utterance at said server, such that said caller identity is transmittable within said trusted telephone network as an authenticated identity of said caller for a call.

The Office Action of August 25, 2005, states that Figure 4A and Figure 4B, column 13, lines 2-41, column 19, lines 49-67, column 20, lines 1-12 and 22-29 of McAllister disclose "receiving a voice utterance for a caller at a server external to a trusted telephone network" as claimed in claim 1 of the present application. The Office Action defines a trusted telephone network of McAllister as only the central office 11 and an SS7 network citing column 11, line 62 and Figure 1. The actual text of McAllister disputes such a definition. Column 11, line 62 is general description of protocols useful in communicating with an Intelligent Peripheral ('IP') and is not in any way a definition of trusted or untrusted networks and in no way defines a trusted telephone network as only a central office and SS7 network. As such, McAllister fails to place one of skill in the art in possession of claim 1. McAllister therefore does not anticipate claim 1. The rejection should be withdrawn and the case should be allowed.

Regarding Figure 1, McAllister explicitly describes Figure 1 as illustrating a single network stating "FIG. 1 provides a simplified illustration of *the* preferred intelligent telephone network for implementing the personal dial tone service in accord with the present invention." McAllister, column 8 lines 37-41, emphasis added. In fact, McAllister does not even mention "trusted telephone networks." McAllister does not disclose "receiving a voice utterance ... at a server external to a trusted telephone network" as claimed in claim 1 of the present application. As such, McAllister fails to place one of skill in the art in possession of claim 1. McAllister therefore does not anticipate claim 1. The rejection should be withdrawn and the case should be allowed.

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Claims 3-5, and 7 depend from independent claim 1 and include all of the limitations of claim 1. Because McAllister does not place one of skill in the art in possession of claim 1, McAllister does not place one of skill in the art in possession of claims 3-5, and 7. As such, claims 3-5, and 7 are also patentable and should be allowed.

Independent claim 10 claims “[a] system for externally identifying a particular caller” including “means for transmitting said caller identity to said trusted telephone network as an authenticated identity of said caller for a call.” As mentioned above, McAllister does not disclose trusted telephone networks and therefore. McAllister does not place one of skill in the art in possession of “[a] system for externally identifying a particular caller” including “means for transmitting said caller identity to said trusted telephone network as an authenticated identity of said caller for a call.” As such, independent claim 10 is not anticipated by McAllister and therefore should be allowed.

Rejected dependent claims 12-14, and 16 depend from claim 10 and include all of the limitations of claim 10. Because McAllister does not place one of skill in the art in possession of claim 10, McAllister also does not place one of skill in the art in possession of claims 12-14, and 16. Claims 12-14, and 16 should be allowed.

Independent claim 18 recites “[a] computer program product for externally identifying a particular caller” including “means, recorded on said recording medium, for controlling transmission of said caller identity to said trusted telephone network as an authenticated identity of said caller for a call.” As discussed above, McAllister does not disclose trusted telephone networks and therefore does not place one of skill in the art in possession of “[a] system for externally identifying a particular caller” including “means for transmitting said caller identity to said trusted telephone network as an authenticated identity of said caller for a call.” As such, independent claim 18 is not anticipated by McAllister and therefore should be allowed.

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Rejected dependent claims 20 and 21 depend from claim 18 and include all of the limitations of claim 18. Because McAllister does not place one of skill in the art in possession of claim 18, McAllister also does not place one of skill in the art in possession of claims 20 and 21. Claims 20 and 21 should be allowed.

Independent claim 52 claims:

A method for controlling caller identification, comprising:

receiving, from a trusted telephone network, an authenticated caller identity for a caller at a telephony device, wherein said caller identity is authenticated at a authentication service accessible via a network external to said trusted telephone network, wherein said trusted telephone network initiates said authentication service; and

controlling output of said authenticated caller identity from said telephony device, such that an individual with access to said telephony device is informed of the identity of said caller.

As discussed above, McAllister does not disclose trusted telephone networks and therefore McAllister does not place one of skill in the art in possession of claim 52. As such, independent claim 52 is not anticipated by McAllister and therefore should be allowed.

CLAIM REJECTIONS – 35 U.S.C. § 103

Claims 2, 9, 11, 19, and 53 stand rejected under 35 U.S.C. § 103(a) as unpatentable over McAllister, *et al.* (U.S. Patent No. 6,038,305) in view of Zirngibl, *et al.* (U.S. Pub. No. 2005/014679). Claims 6 and 15 stand rejected under 35 U.S.C. § 103(a) as unpatentable over McAllister, *et al.* (U.S. Patent No. 6,038,305) in view of McAllister, *et al.* (U.S. Patent No. 6,442,242). Claims 8 and 17 stand rejected under 35 U.S.C. § 103(a) as

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unpatentable over McAllister, *et al.* (U.S. Patent No. 6,038,305) in view of Yoon, *et al.* (U.S. Pub. No. 2001/0047414).

To establish a prima facie case of obviousness, three basic criteria must be met. *Manual of Patent Examining Procedure* §2142. The first element of a prima facie case of obviousness under 35 U.S.C. § 103 is that the proposed combination of the references must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). The second element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a suggestion or motivation to combine the references. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The third element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a reasonable expectation of success in the proposed combination of the references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). Each of the proposed combinations fail to establish a prima facie case of obviousness.

McAllister and Zirngibl**The Combination of McAllister and Zirngibl**
Does Not Teach all of Applicants' Claim Limitations

Claims 2, 9, 11, 19, and 53 stand rejected under 35 U.S.C § 103(a) as unpatentable over McAllister, *et al.* (U.S. Patent No. 6,038,305) in view of Zirngibl, *et al.* (U.S. Pub. No. 2005/014679). To establish a prima facie case of obviousness under 35 U.S.C. § 103 the proposed combination of McAllister and Zirngibl must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). Claims 2, 9, 11, 19, and 53 recite a trusted telephone network. As described above, McAllister fails to disclose trusted telephone networks. Zirngibl does not cure the deficiencies of McAllister and the Office Action fails to cite any teaching in Zirngibl teaching trusted telephone networks instead citing Zirngibl as teaching a secure channel. Neither McAllister nor Zirngibl disclose trusted telephone networks and therefore do not

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teach or suggest all the limitations of claims 2, 9, 11, 19, and 53. As such, the combination of McAllister and Zirngibl cannot support a *prima facie* case of obviousness.

No Suggestion or Motivation to Combine McAllister and Zirngibl

There is no suggestion or motivation to combine McAllister and Zirngibl. To establish a *prima facie* case of obviousness under 35 U.S.C. § 103 there must be a suggestion or motivation to combine McAllister and Zirngibl. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The suggestion or motivation to combine McAllister and Zirngibl must come from the teaching of McAllister or Zirngibl themselves, and the Examiner must explicitly point to the teaching within either reference suggesting the proposed combination. Absent such a showing, the Examiner has impermissibly used “indsight” occasioned by Applicants’ own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.2d 488m 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989).

The Office Action at page 5 states its rationale for motivation to combine McAllister and Zirngibl as:

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify McAllister to incorporate a secure channel as taught by Zirngibl. The motivation for the modification is to have doing so in order to provide a secure exchange of data between two communication entities.

The above reference in the Office Action does not point to any specific teaching in either McAllister or Zirngibl suggesting such a combination. Instead, the Office Action merely makes a naked assertion that there is a motivation for combining the references. Such an assertion, without more, is incomplete and improper. As such, the proposed combination cannot establish a *prima facie* case of obviousness and the rejection should be withdrawn.

McAllister and McAllister

The Combination of McAllister and McAllister
Does Not Teach all of Applicants' Claim Limitations

Claims 6 and 15 stand rejected under 35 U.S.C § 103(a) as unpatentable over McAllister, *et al.* (U.S. Patent No. 6,038,305) in view of McAllister, *et al.* (U.S. Patent No. 6,442,242). To establish a prima facie case of obviousness under 35 U.S.C. § 103 the proposed combination of McAllister and McAllister must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). Neither McAllister nor McAllister teach or suggest all of the limitations of claims 6 and 15. As described above, McAllister (U.S. Patent No. 6,038,305) fails to disclose trusted telephone networks. McAllister (U.S. Patent No. 6,442,242) does not cure the deficiencies of McAllister. The Office Action fails to cite any teaching in McAllister teaching trusted telephone networks instead citing McAllister as teaching a private switching system and a secure channel at Figure 1, column 4, lines 44-49. Column 4, lines 44-49 actually disclose:

According to an embodiment of the invention shown in FIG. 1, a private automatic branch exchange (PBX) 10 is located at a customer facility in the form of customer premises equipment (CPE). Alternatively, this functionality may be provided by telephone company (telco) central office (CO) equipment such as CENTREX service or may be provided to subscribers on a subscription basis and incorporated into an intelligent peripheral (IP) of an advanced intelligent network (AIN).

Column 4, lines 44-49 does not disclose trusted telephone networks or secure channels. Neither McAllister nor McAllister disclose trusted telephone networks and therefore do not teach or suggest all the limitations of claims 6 and 15. As such, the combination of McAllister and McAllister cannot support a prima facie case of obviousness.

No Suggestion or Motivation to Combine McAllister and McAllister

There is no suggestion or motivation to combine McAllister and McAllister. To establish a *prima facie* case of obviousness under 35 U.S.C. § 103 there must be a suggestion or motivation to combine McAllister and McAllister. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The suggestion or motivation to combine McAllister and McAllister must come from the teaching of McAllister or McAllister themselves, and the Examiner must explicitly point to the teaching within either reference suggesting the proposed combination. Absent such a showing, the Examiner has impermissibly used “hindsight” occasioned by Applicants’ own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.2d 488m 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989).

The Office Action at page 6 states its rationale for motivation to combine McAllister and McAllister as:

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify McAllister'305 to incorporate a secure channel as taught by McAllister'242. The motivation for the modification is to have doing so in order to make use of private lines over carried transmission facilities.

The above reference in the Office Action does not point to any specific teaching in either McAllister or McAllister suggesting such a combination. Instead, the Office Action merely makes a naked assertion that there is a motivation for modifying and combining the references. Such an assertion, without more, is incomplete and improper. As such, the proposed combination cannot establish a *prima facie* case of obviousness and the rejection should be withdrawn.

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McAllister and Yoon

The Combination of McAllister and Yoon

Does Not Teach all of Applicants' Claim Limitations

Claims 8 and 17 stand rejected under 35 U.S.C § 103(a) as unpatentable over McAllister, *et al.* (U.S. Patent No. 6,038,305) in view of Yoon, *et al.* (U.S. Pub. No. 2001/0047414). To establish a *prima facie* case of obviousness under 35 U.S.C. § 103 the proposed combination of McAllister and Yoon must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). Claims 8 and 17 recite a trusted telephone network. As described above, McAllister fails to disclose trusted telephone networks. Yoon does not cure the deficiencies of McAllister and the Office Action fails to cite any teaching in Yoon teaching trusted telephone networks instead citing Yoon as teaching an IP from the PSTN network through a dedicated private network at the abstract, Figure 2 and paragraph 0073. The Office Action basis its rejection the phrase 'IP' in Yoon and equating the phrase 'IP' of Yoon with a server. 'IP' as described in Yoon stands for 'Internet Protocol,' which is a protocol. The Internet Protocol is not a server. Neither McAllister nor Yoon disclose trusted telephone networks and therefore do not teach or suggest all the limitations of claims 8 and 17. As such, the combination of McAllister and Yoon cannot support a *prima facie* case of obviousness.

No Suggestion or Motivation to Combine McAllister and Yoon

There is no suggestion or motivation to combine McAllister and Yoon. To establish a *prima facie* case of obviousness under 35 U.S.C. § 103 there must be a suggestion or motivation to combine McAllister and Yoon. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The suggestion or motivation to combine McAllister and Yoon must come from the teaching of McAllister or Yoon themselves, and the Examiner must explicitly point to the teaching within either reference suggesting the proposed combination. Absent such a showing, the Examiner has impermissibly used

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"hindsight" occasioned by Applicants' own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.2d 488m 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.,2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989).

The Office Action at page 5 states its rationale for motivation to combine McAllister and Yoon as:

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify McAllister to allow external network as a private network connected as taught by Yoon. The motivation for the modification is to have the private connection in order to make use of private lines over carried transmission.

The above reference in the Office Action does not point to any specific teaching in either McAllister or Yoon suggesting such a modification or combination. Instead, the Office Action merely makes a naked assertion that there is a motivation for combining the references. Such an assertion, without more, is incomplete and improper. As such, the proposed combination cannot establish a *prima facie case* of obviousness and the rejection should be withdrawn.

BRIEF IN SUPPORT OF REINSTATEMENT OF APPEALNo Reasonable Expectation of Success in the
Proposed Combination of McAllister and Yoon

To establish a *prima facie* case of obviousness, there must also be a reasonable expectation of success in the proposed combination of McAllister and Yoon. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). There is no reasonable expectation of success in the proposed combination. The office action basis its rejection the phrase 'IP' in Yoon and equating the phrase 'IP' of Yoon with a server. 'IP' as described in Yoon stands for 'Internet Protocol,' which is a protocol. The Internet Protocol is not a server. Because the IP of Yoon is not a server, the suggested combination cannot work as described in the office action. The rejection should therefore be withdrawn and the case should be allowed.

The Four Factual Inquiries Required By The Supreme Court For An Obviousness
Rejection Have Not Been Properly Considered, Determined, And Applied

Establishing a *prima facie* case of obviousness for claims 2, 6, 8, 9, 11, 15, 17, 19, and 53, which has not been accomplished, is not the end of obviousness analysis, it is the beginning. The rejection of these claims under 35 U.S.C. 103 are deficient because the proper factual inquiries have not been considered, determined, and applied as required by the Supreme Court in *Graham v. John Deere*. The rejection should therefore be withdrawn and the case allowed.

The Manual of Patent Examining Procedure §2141 explicitly states:

Patent examiners carry the responsibility of making sure that the standard of patentability enunciated by the Supreme Court and by the Congress is applied in each and every case. The Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966), stated:

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Under Section 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy...

This is not to say, however, that there will not be difficulties in applying the nonobviousness test. What is obvious is not a question upon which there is likely to be uniformity of thought in every given factual context. The difficulties, however, are comparable to those encountered daily by the courts in such frames of reference as negligence and scienter, and should be amenable to a case-by-case development. We believe that strict observance of the requirements laid down here will result in that uniformity and definitiveness which Congress called for in the 1952 Act.

Office policy has consistently been to follow *Graham v. John Deere Co.* in the consideration and determination of obviousness under 35 U.S.C. 103. As quoted above, the four factual inquires enunciated therein as a background for determining obviousness are briefly as follows:

- (A) Determining of the scope and contents of the prior art;

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(B) Ascertaining the differences between the prior art and the claims in issue;

(C) Resolving the level of ordinary skill in the pertinent art; and

(D) Evaluating evidence of secondary considerations.

Manual of Patent Examining Procedure §2141.

In over three years of prosecution and after issuing five office actions, the Examiner has yet to even mention the four factual inquiries required by the Supreme Court in *Graham v. John Deere*, and none of the four factual inquiries has been properly considered, determined, and applied in any of the office actions in this case.

The first factual inquiry that has not been properly considered and determined is ascertaining the differences between the prior art and the claims in issue. More particularly, in each office action, the Examiner has only identified elements in Applicants' claims not found in one reference and then attempted to find a similar element in another reference to support an obviousness rejection. Such analysis is improper and incomplete. "Ascertaining the differences between the prior art and the claims at issue requires interpreting the claim language, and considering both the invention and the prior art references as a whole." MPEP §2141.02. Furthermore, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." *Id.*, citing *Stratoflex, Inc. v. Aerquip Corp.*, 713 F.2d 1530 (Fed. Cir. 1983). The office actions of April 23, 2003, October 8, 2003, August 12, 2004, March, 24, 2005, and August 25, 2205 are deficient because the Examiner has only identified differences between Applicants' claims and the various references including McAllister, McAllister, Zirmgibl, and Yoon. This analysis is improper and incomplete because Examiner has not determined whether

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Applicants' claims as a whole would have been obvious in view of any of the proposed combinations of the references as required by the Manual of Patent Examining Procedure. In fact, the Examiner has not even mentioned how any claim as a whole would be obvious in rejecting any claim. As such, the obviousness rejections should be withdrawn and the case should be allowed.

The second factual inquiry that has not been properly considered, determined, and applied is resolving the level of ordinary skill in the pertinent art. "The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry." MPEP §2141.03 citing *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718, 21 USPQ2d 1053, 1057 (Fed. Cir. 1991). "The examiner must ascertain what would have been obvious to one of ordinary skill in the art at the time the invention was made, and not to the inventor, a judge, a layman, those skilled in remote arts, or to geniuses in the art at hand." *Id.* citing *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 218 USPQ 865 (Fed. Cir. 1983), cert. denied, 464 U.S. 1043 (1984). "Factors that may be considered in determining level of ordinary skill in the art include (1) the educational level of the inventor; (2) type of problems encountered in the art; (3) prior art solutions to those problems; (4) rapidity with which innovations are made; (5) sophistication of the technology; and (6) educational level of active workers in the field." *Id.* citing *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 696, 218 USPQ 865, 868 (Fed. Cir. 1983), cert. denied, 464 U.S. 1043 (1984). The office actions of April 23, 2003, October 8, 2003, August 12, 2004, and March 24, 2005 fail to apply a single factor to consider in determining the level of ordinary skill in the art. In fact, in over three years of prosecution and five office actions, no analysis at all considering the level of one of ordinary skill in the art for the instant case has been performed. The rejection is therefore deficient and the case should be allowed.

CONCLUSION

McAllister does not disclose each and every element of or enable claims 1, 3-5, 7, 10, 12-14, 16, 18, 20, 21 and 52. McAllister therefore does not anticipate claims 1, 3-5, 7, 10, 12-14, 16, 18, 20, 21 and 52. The proposed combinations of McAllister and Zirmgibl, McAllister and McAllister, and McAllister and Yoon fail to establish a prima facie case of obviousness because the proposed combinations do not satisfy each of the required elements of a prima facie case of obviousness. Applicants respectfully request the allowance of Applicants claims.

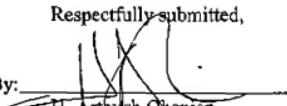
In view of the forgoing arguments, reversal on all grounds of rejection is requested.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Date: December 14, 2006

Respectfully submitted,

By:


H. Arbusch Ohanian
Reg. No. 46,022
Biggers & Ohanian, LLP
P.O. Box 1469
Austin, Texas 78767-1469
Tel. (512) 472-9881
Fax (512) 472-9887
ATTORNEY FOR APPELLANTS

BRIEF IN SUPPORT OF REINSTATEMENT OF APPEAL

**APPENDIX OF CLAIMS
ON APPEAL IN PATENT APPLICATION OF
MICHAEL WAYNE BROWN, *ET AL.*, SERIAL NO. 10/015,281**

CLAIMS

What is claimed is:

1. A method for externally identifying a particular caller, said method comprising:
 - receiving a voice utterance for a caller at a server external to a trusted telephone network; and
 - identifying a caller identity associated with said voice utterance at said server, such that said caller identity is transmittable within said trusted telephone network as an authenticated identity of said caller for a call.
2. The method for externally identifying a particular caller according to claim 1, wherein receiving a voice utterance further comprises:
 - receiving said voice utterance through a secure channel between said server and said trusted telephone network.
3. The method for externally identifying a particular caller according to claim 1, further comprising:

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receiving, at said server, a request for a caller identity authentication service from said trusted telephone network; and

prompting said caller to provide said voice utterance.

4. The method for externally identifying a particular caller according to claim 1, wherein identifying a caller identity further comprises:
 - extracting speech characteristics from said voice utterance; and
 - comparing said speech characteristics with a plurality of voice samples stored for identifying a plurality of callers.
5. The method for externally identifying a particular caller according to claim 1, wherein said trusted telephone network comprises at least one public switching telephone network.
6. The method for externally identifying a particular caller according to claim 1, wherein said trusted telephone network comprises a private switching system.
7. The method for externally identifying a particular caller according to claim 1, further comprising:
 - accessing said server from said trusted telephone network through an Internet connection.
8. The method for externally identifying a particular caller according to claim 1, further comprising:
 - accessing said server from said trusted telephone network through a private network connection.

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9. The method for externally identifying a particular caller according to claim 1, further comprising:
 - transferring said caller identity to said trusted telephone network through a secure channel.
10. A system for externally identifying a particular caller, said system comprising:
 - a server system communicatively connected to a trusted telephone network by an external network;
 - means for receiving a voice utterance for a caller at said server system;
 - means for identifying a caller identity associated with said voice utterance;
 - means for transmitting said caller identity to said trusted telephone network as an authenticated identity of said caller for a call.
11. The system for externally identifying a particular caller according to claim 10, wherein said means for receiving a voice utterance further comprises:
 - means for receiving said voice utterance through a secure channel between said server system and said trusted telephone network.
12. The system for externally identifying a particular caller according to claim 10, further comprising:
 - means for receiving, at said server system, a request for a caller identity authentication service from said trusted telephone network; and
 - means for prompting said caller to provide said voice utterance.

13. The system for externally identifying a particular caller according to claim 10, wherein said means for identifying a caller identity further comprises:
 - means for extracting speech characteristics from said voice utterance; and
 - means for comparing said speech characteristics with a plurality of voice samples stored for identifying a plurality of callers.
14. The system for externally identifying a particular caller according to claim 10, wherein said trusted telephone network comprises at least one public switching telephone network.
15. The system for externally identifying a particular caller according to claim 10, wherein said trusted telephone network comprises a private switching system.
16. The system for externally identifying a particular caller according to claim 10, wherein said external network is the Internet.
17. The system for externally identifying a particular caller according to claim 10, wherein said external network is a private network.
18. A computer program product for externally identifying a particular caller, said computer program product comprising:
 - a recording medium;

means, recorded on said recording medium, for enabling receipt of a voice utterance for a caller at a server system communicatively connected to a trusted telephone network via an external network;

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means, recorded on said recording medium, for identifying a caller identity associated with said voice utterance;

means, recorded on said recording medium, for controlling transmission of said caller identity to said trusted telephone network as an authenticated identity of said caller for a call.

19. The computer program product for externally identifying a particular caller according to claim 18, further comprising:

means, recorded on said recording medium, said voice utterance through a secure channel between said server system and said trusted telephone network.

20. The computer program product for externally identifying a particular caller according to claim 18, further comprising:

means, recorded on said recording medium, for enabling receipt at said server system of a request for a caller identity authentication service from said trusted telephone network; and

means, recorded on said recording medium, for prompting said caller to provide said voice utterance.

21. The computer program product for externally identifying a particular caller according to claim 18, further comprising:

means, recorded on said recording medium, for extracting speech characteristics from said voice utterance; and

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means, recorded on said recording medium, for comparing said speech characteristics with a plurality of voice samples stored for identifying a plurality of callers.

52. A method for controlling caller identification, comprising:

receiving, from a trusted telephone network, an authenticated caller identity for a caller at a telephony device, wherein said caller identity is authenticated at a authentication service accessible via a network external to said trusted telephone network, wherein said trusted telephone network initiates said authentication service; and

controlling output of said authenticated caller identity from said telephony device, such that an individual with access to said telephony device is informed of the identity of said caller.

53. A method for controlling a call, comprising:

receiving, at a telephony device, a secure communication channel via a trusted telephone network to an authentication service, wherein said trusted telephone network initiates said authentication service; and

facilitating, from said telephony device, communications between said authentication service and a caller, such that said authentication service is enabled to authenticate an identity of said caller.

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**APPENDIX OF EVIDENCE
ON APPEAL IN PATENT APPLICATION OF
MICHAEL WAYNE BROWN, *ET AL.*, SERIAL NO. 10/015,281**

This is an evidence appendix in accordance with 37 CFR § 41.37(c)(1)(ix).

There is in this case no evidence submitted pursuant to 37 CFR §§ 1.130, 1.131, or 1.132, nor is there in this case any other evidence entered by the examiner and relied upon by the Appellants.

BRIEF IN SUPPORT OF REINSTATEMENT OF APPEAL

RELATED PROCEEDINGS APPENDIX

This is a related proceedings appendix in accordance with 37 CFR § 41.37(c)(1)(x).

There are no decisions rendered by a court or the Board in any proceeding identified pursuant to 37 CFR § 41.37(c)(1)(ii).